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**EXPEDITED
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Eiroku Go

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Technology Center 2600

TITLE: DIGITAL ADVERTISING METHOD UTILIZING A CELLULAR
TELEPHONE DISPLAY

Examiner: Temica M. Davis Art Unit: 2681

Atty Docket No. 505500-56

RESPONSE UNDER 37 CFR 1.116

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is in response to the Office Action dated April 21, 2004 having a
response due date set to expire on July 21, 2004.

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REMARKS

Claims 1, and 4-9 are active. Claims 1, and 4-9 are rejected under 35 USC 103 as being unpatentable over Calvert in view of Hymel.

Applicant respectively requests reconsideration of claims 1 and 4-9 and traverses the rejection of claim 1. Applicant believes claim 1 is unobvious over the Calvert and Hymel references individually and in combination.

Claim 1 calls for:

broadcasting selected advertisements for display on a display screen of a cellular telephone receiver receiving a request call in the system;

classifying emergency information in the classified categories
(underlining added)

The underlined portions noted above are not suggested or disclosed by Calvert. The Office Action states that Calvert discloses a digital advertising method comprising broadcasting selected advertisements for display on a display screen of a cellular telephone. This broadcasting aspect is not true.

Calvert does not disclose a broadcasting system as asserted. Broadcasting as reasonably interpreted in claim 1 and in view of applicant's specification (the intrinsic evidence) means the simultaneous transmission of information to numerous recipients, which may number in the thousands or tens of thousands, for example. The ordinary and customary meaning of the claim term

"broadcasting" should be used when construing the claim. MPEP 2111.01 states that, during examination, the words of the claim must be given their "plain meaning" unless they are defined [differently] in the specification. That is, the patentee must expressly intend to disclaim the ordinary and customary meaning of the term. If there is no such disclaimer in the patent, the ordinary and customary (the plain) meaning is used as would be understood by one of ordinary skill in this art. The court must look to the patent itself, including the claims, and the specification. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F. 3d 1576, 1582 (Fed. Cir. 1996).

The dictionary definition of the term "broadcast" is "to scatter or disseminate something widely." The Random House College Dictionary 1975 at 171. This is consistent with applicant's specification page 7, lines 9-11 wherein it is stated that "an advertisement is displayed . . . to specified areas . . . or to all cellular telephones." (underlining added) Certainly the term "areas" means geographic areas which can include thousands or tens of thousands of recipient telephones. Claim terms have the same meaning as in the specification. *Cybor Corp. v. Fas Technologies, Inc.*, 138 F.3d 1448, 1457, (Fed. Cir. 1998). It is the language of the claims that defines the scope of the invention. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F. 3d 1323, 1331 (Fed. Cir. 2001). There is a heavy presumption that the terms used in the claims mean what they say and

have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. *Resonate v. Alton Web Systems*, 338 F.3d 1360 (Fed Cir. 2003) citing cases.

In view of the above plain meaning of the term broadcast as meaning to scatter over a wide area, Calvert does not broadcast the requested information over a wide area by scattering or otherwise as claimed and as asserted by the Office Action. In Calvert, after a cellular telephone user makes the first initiation to search for a product, which system acts as a search engine for specific information related to a selected product, the context search database transmits the product data only to that person/user, which is not a broadcast in the context of claim 1. Col. 7, lines 31-44, col. 10, lines 33-37, col. 11, lines 26-32, the latter stating "the present invention is directed to advertising to consumers on an individual basis." This is inapposite to what is claimed in the use of the term "broadcasting."

To this end the Calvert system determines the location of the communication device and is in response to a request from that individual. Col. 11, lines 52-60. The system must receive a request for a product from that cell phone. (lines 58-60). This system is not a broadcast system in the context of claim 1. The cited patent col. 6, line 66 to col. 7, line 30 is consistent with the above and does not support the position of the Office Action, e.g., line 12, col. 7,

"Responsive to signaling from the user input device 213 ... the processor directs the stored information . . . to the display 209." (underlining added) Plainly this system does not broadcast as intended by the term in claim 1.

Further, the direction to start the transmission to the user in Calvert comes from the user. This is not so in claim 1 method. Broadcasting widely to a large number of users is counter to any initiation of such transmissions by the user. By definition, initiation of the transmission to the user being in response to a request from the user does not involve broadcasting as claimed, but is merely a search request. A response to a search request is not within the context of broadcasting as intended by applicant. This reference is foreign to claim 1 which is unobvious thereover.

Hymel is cited as disclosing a method of providing news and weather and thus adds nothing to Calvert with respect to the claimed term "broadcasting." Hymel discloses selective call radios (SCR) which direct messages to selected users somewhat similar to Calvert. This too is not broadcasting in accordance with the plain meaning of this term as discussed above. Therefore, Hymel does not add anything to Calvert in this regard. For these reasons alone, claim 1 is believed allowable. But claim 1 calls for more.

Claim 1 calls for

"classifying the advertisements into respective categories among which pre-selected and approved categories' advertisements by the receiver are received on the display screen." (underlining added)

This classifying of the advertisements into respective categories is missing in both cited references. Also, the pre-selected and approved categories' advertisements by the receiver as received on the display screen is also missing in both cited references.

Applicant has carefully reviewed these references and fails to find a teaching of such classification. The Office Action refers to Calvert, col. 12, lines 37-52 and col. 16, lines 40-56 as teaching such classifying. This is not so and certainly there is no such classifying.

Applicant disagrees that the reference discloses this subject matter in these locations. Col. 12, lines 37-57 and col. 16, lines 40-56 do not disclose classifying advertisements in categories as claimed.

Col. 12 states that the search engine would search for a fast food restaurant in Dallas to see if there any such restaurants. This statement does not refer to classifying the advertisements into categories, much less for pre-selection at a receiver. The reference discloses merely responding to a request from the user and has nothing to do with

broadcast advertisements that are classified for selection by the receiver. The reference is silent as to how the information is stored in the search data base, i.e., it does not disclose classifying in the search data base, much less for selection in the user's receiver. Mere searching for information is not related to classification. It is not known from the reference how or if the information is classified. The section at col. 16 is equally foreign to this aspect of claim 1. Displaying a list of providers is hardly related to classifying advertisements in categories for selection by the user. In any case, providing information in a search data base, which is not disclosed as being classified in categories, is foreign to classifying advertisements for pre-selection in the receiving phone as claimed in claim 1. If the Examiner persists in this rejection, she is respectfully requested to explain how these sections relate to what is claimed in detail. Applicants believe they are foreign to claim 1 and are not relevant. None of the cited references provides a teaching, much less a suggestion, of the claimed classifying step for pre-selection in the receiver.

Calvert discloses a search engine type of product search. The cell phone user tries to obtain a product or service in nearby areas. This reference deals with how to find information that exists in data bases

elsewhere. Calvert's focus is on how to find information as needed based on current location of the user. Further, the direction to start the communication is different in the claim as compared to the reference. In the reference the user makes the first or initial step to obtain product information and receives this information only once. This user initiation will connect to the context engine data base to search whether the desired product is available in the general nearby vicinity of the user's location. The claimed invention is different in kind as the frequency of transmission is dependent upon the transmitter, not the user.

In Calvert, the information is transmitted only to the initiating user.

In the claimed invention, the information is broadcast to a wide audience. The frequency of transmission is different. In Calvert, it occurs once. In the claimed invention, there is no limit as the advertisements may be repeated if desired as many times as desired by the advertiser. The same data may be broadcast repetitively if desired.

Calvert discloses a two way communication. The claimed invention relates to a one way communication, reception only at the receiver, which is defined by the claim and foreign to the disclosed receivers of the references. For this additional reason, claim 1 is believed allowable.

Claim 1 calls for more. The claim includes "classifying emergency information in the classified categories." The Office Action admits that Calvert fails to disclose classifying includes classifying emergency information, but cites Hymel for this aspect. This is error. Hymel also does not disclose classifying advertisements in categories for pre-selection in the receiver, much less classifying emergency information. Hymel discloses advertising, news and weather in col. 1, lines 23-27, however, an impermissible assumption is made that this teaches classifying emergency information into a category for pre-selection in the receiver as claimed in claim 1. Neither reference discloses any classifying of any information for pre-selection of the broadcast information at the receiver into categories as discussed above, much less classifying emergency information in a separate category for such pre-selection. The mere fact that a receiver can generally receive news and weather information does not infer that such information is classified for pre-selection by the receiver in an assigned category as such. The references do not teach or disclose any such classification into categories or such pre-selection by category at the receiver as claimed.

The Office Action states the Hymel "messages include weather and news." This statement is irrelevant to what is claimed and misses

the point. Merely transmitting weather or news is not a per se classification into a category. The fact that this information may fall into a category does not mean it is so classified. This step is missing. Hymel does not disclose a classification system into categories as claimed, per se. The mere fact that the Examiner considers such transmitted information as lying in a category is not relevant to whether in fact there is such classification, which applicant maintains there is none suggested.

The Office Action does not address this aspect of claim 1 which is missing in both Calvert and Hymel. The Office Action is silent as to where in Hymel there is a classification of messages into categories and which are pre-selected per category by the receiver as claimed in claim 1.

The definition of category means that all information is related to a common definition, a "group." *The Random House College Dictionary*, p. 212. The term "emergency" means that ordinary news, sports and other such information is distinct therefrom and thus from emergency situations, which demand immediate action. One of ordinary skill would not construe the terms weather or news as generally as an emergency information. While some news and some weather are considered by the Office Action as constituting emergencies, this is not what is claimed. The news or weather must be categorized in a special category titled

"emergency." One would not categorize news and weather generally in such an emergency category. There is no teaching in Hymel of such classification.

The plain meaning of the claim language "emergency information" should be used when construing the claim term as classified into a category. Weather and news do not fall into a category that would be designated "emergency." Hymel does not disclose such a special category. MPEP 2111.01 states that, during examination, the words of the claim must be given their "plain meaning" unless they are defined in the specification. The dictionary definition of the term "emergency" is:

"A serious situation or occurrence that happens unexpectedly and demands immediate action." *The American Heritage® Dictionary of the English Language, Fourth Edition* (Houghton Mifflin Company, 2000).

This information must also be classified into a category. The reference does not do this. The definition of "emergency" clearly shows that ordinary news, sports and other such information is distinct from emergency situations which demand immediate action. Not all news and weather are emergencies that would be categorized as such. However, regardless the Examiner's interpretation of the term emergency, there is no classification of such emergency information in Hymel as discussed at length above. The mere transmission of weather or news is not related to whether or not the receiver pre-selects information that is

classified as emergency. The claim calls for the receiver to pre-select information that is classified in a category "emergency." As discussed above there is no suggestion of classification into categories of any information by the disclosed receivers of the cited references, much less emergency information. This classification permits the user to select this category specifically for such information. Calvert and Hymel do not have any provisions for a user to select from his receiver a category of information to be received, much less emergency information. These references are foreign to this concept as claimed. It is the claimed terms that must be reviewed, not general concepts which are foreign to the specific claim terms.

By way of example, as discussed in Applicant's specification, (pages 4-5, lines 24-1), in the case of an emergency notification, breaking news (earthquake and natural disaster) is transmitted to all cellular telephone holders in the concerned areas (specified relay stations) and this information is in a selected classified category in the receiver. Further, the distinction between emergency and ordinary information is discussed in the embodiment in Applicant's specification in which pre-assigned identification codes are set up to identify and select whether the type of request call is one to N, particularly which category of advertisement, an emergency notification or one to one type. For example, Tennis in sports is #85, an emergency notification is #999, person to person (one to one) type of

telephone call is #800, and absence call is #803 (specification, page 5, lines 5-8).

Clearly, emergency information is distinct from other types of information according to the plain meaning found in the dictionary, and used in the embodiment of Applicant's specification.

The Office Action concedes that the Calvert reference does not disclose the classifying step including classifying emergency information (page 4, paragraph 5). Hymel also does not disclose this subject matter. Obviousness requires the claimed steps or elements be suggested by the prior art. This is missing. Therefore, claim 1 is not suggested by Calvert or Hymel. The conclusions of the Office Action are not supported by the cited references.

A *prima facie* case for obviousness has not been established with respect to claim 1. To establish a *prima facie* case for obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (MPEP 2143.03). MPEP 2143.01 states that the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness, and the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. The MPEP states that the prior art need also suggest the desirability of the modification or combination. Further, the MPEP states that it is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the

references. However, since both references are missing what is claimed, their combination still would not suggest claim 1. Claim 1 is believed allowable.

Claims 4-7 are also rejected under 35 USC 103 as obvious over Calvert and Hymel. Claims 4-7 are dependent on claim 1 and are believed allowable for at least the same reasons given for claim 1.

Claims 4-7 claim a broadcast type advertising method without a communication being established to a receiver (specification pages 4-5, lines 26-1), in addition to the user classifying the advertisements and emergency information in pre-selected and approved categories. The claimed broadcasting and categorization is missing from Calvert and Hymel.

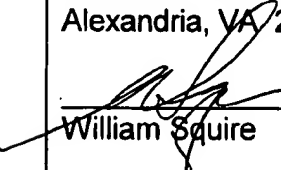
In respect of claim 8, Calvert and Hymel do not provide a motivation or objective reason to modify their teachings to arrive at the claimed invention. Calvert does not disclose categorizing groups consisting of emergencies, sports, shopping, and investing. The Office Action concludes that it would have been obvious to a person of ordinary skill in the art to modify Calvert to include the services of emergencies, sports, shopping and investing as disclosed in Hymel. Applicant disagrees as discussed under claim 1 above in regard to Calvert and Hymel which do not disclose such classifying. Applicant believes claim 8 is allowable.

Claim 9 includes subject matter common to claim 1 and dependent claims 4-8, such as classifying emergency information, and a digital broadcast type

advertising including a one to N type broadcasting, as well as additional subject matter. See also applicant's prior filed communication for additional discussion incorporated by reference herein. Thus, claim 9 is believed to be unobvious over the references cited above for at least the same reasons as discussed above, as well as, the additional subject matter claimed. Claim 9 is believed allowable.

For the reasons given, claims 1, and 4-9 are believed to be in condition for allowance, and such favorable action is hereby requested.

The Commissioner is authorized to charge any fees due for this paper or credit any overpayments to Deposit Account No. 03-0678.

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 William Squire	<u>July 9, 2004</u> Date

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Respectfully submitted,
Eiroku Go.

By: 
William Squire, Reg. No. 25,378
Attorney for Applicants

Phone: 973-994-1700
Fax: 973-994-1744